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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 08/666,653 | 06/18/1996 | TSUTOMU HONDA | 024060-064 | 7870 |

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| EXAMINER | |
|---|---|
| MOE, AUNG SOE | |
| **ART UNIT** | **PAPER NUMBER** |
| 2685 | |

DATE MAILED: 09/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 08/666,653 | HONDA ET AL. | |
| | Examiner | Art Unit | |
| | Aung S. Moe | 2685 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *29 June 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *31-42* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *31-42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

***Response to Arguments***

1. Applicant's arguments filed 6/29/2005 have been fully considered but they are not persuasive.

Regarding claims 31, 35, 39 and 41, the Applicant alleged that nothing in Kozuki '943 shows, teaches or suggests a reproducing mode in which a still picture is reproduced out of a moving picture which is recorded to be reproduced as a moving picture as claimed in claims 31, 35, 39 and 41.

In response, the Examiner respectfully disagrees because Kozuki '943 does in fact disclose the above-mentioned claimed invention. In particular, Kozuki '943 clearly shown in Fig. 9 that a still picture (i.e., noted the still picture M5 is continuously recorded in the corresponding moving-image recording area M1-M18 as shown in Fig. 9) can be reproduced out of a moving picture (i.e., M1-M18) which is recorded to be reproduced as a moving picture (i.e., noted that the picture signals from the track M1-M18 of the recording area 5 is recorded to be reproduced as a moving picture). In view of this, Kozuki '943 clearly teaches a mode in which the still picture contents of the tracks M5 as shown in Fig. 9 which is recorded on the second recording medium (i.e., the tape 1, the area 5) can be reproduced out of the moving picture (M1-M18) as a frozen still image so that it is possible to realize a magnetic recording apparatus which permits an operator to easily understand the contents and recording timing of a picture recorded as a still image during the reproduction of a moving image as suggested in col. 8, lines 30-68.

In view of the above, having a system of Ootsuka '754 for performing multiple different operation mode for reproducing a still picture and a moving picture and then given the well-

established teaching of Kozuki '943, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Ootsuka '754 as taught by Kozuki '943, since Kozuki '943 suggested in col. 8, lines 45+ that such a modification would enable the operator to easily confirm the timing when the still image was recorded and the contents thereof, and moreover, such a modification would obviously reduce the cost and size of the overall system of Ootsuka '754 because it is only require to use a single recording medium to recorded the still and moving image data as taught by Kozuki '943.

Therefore, the Examiner continues to assets that the present claimed invention is obvious over the combination of Ootsuka '754 and Kozuki '943 for at least the reasons discussed above and the previous rejection is hereby maintained.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 31-33, 34-38 and 39-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ootsuka '754 (U.S. 5,774,754) in view of Kozuki et al. (U.S. 5,589,943).

Regarding claim 31, Ootsuka '754 discloses a photographing apparatus *(see Figs. 2 and 18)* comprising:

a first recording section for recording, on a first recording medium *(i.e., noted the use of a silver salt film as shown in Fig. 4)*, mainly still pictures together with information relating to the still pictures thus recorded *(as shown in Figs. 4 and 5A, it is noted that with the use of the magnetic recording circuit, the information relating to the still pictures recorded on the film may be recorded on a magnetic recording layer of the film so that such information may be used when a still picture recorded on the film is printed; see col. 7, lines 10+)*;

a second recording *(i.e., noted the use of Memory 50)* section capable of recording moving pictures and also pictures to be reproduced as still pictures (i.e., col. 6, lines 30+); and a controller (Figs. 1 and 18, the elements 1 and 100) for controlling the photographing apparatus (i.e., the system 20), which is operated by a voluntary operation (i.e., noted the use of manual switches as shown in Fig. 3 for allowing the user to perform a voluntary operation) a plurality of shooting and reproducing modes *(i.e., noted that with the use of control units 1 and 100 and the input units, e.g., the elements 24-25, 39, & 40, the user may select among a plurality of shooting*

*and reproducing modes; see col. 6, lines 29+ and col. 27, lines 20+)*, said shooting modes including a mode in which a still picture and information relating thereto are recorded on the first recording medium *(see Figs. 4 & 5A, col. 6, lines 40+ and col. 7, lines 3+)*,

a mode in which a moving picture is recorded on the second recording medium (50), and a mode in which a picture to be reproduced as a still picture is recorded on the second recording medium *(i.e., noted that both still/moving image signals generated by the image pickup device and signal processing unit have to record on the image memory unit 50, so that they may be reproduced to display on the display monitor; see Figs. 8, 12-13, 18 and 38, the elements 50 & 127; col. 15, lines 60+ and col. 27, lines 20+)*,

said reproducing modes including a mode in which information relating to a still picture recorded on the first recording medium is displayed *(Figs. 13-14, col. 10, lines 45+, col. 12, lines 10+, col. 11, lines 20+ and col. 23, lines 40+)*,

a mode in which a moving picture recorded on the second recording unit (50) is reproduced *(col. 15, lines 65+ and col. 28, lines 25+)*,

a mode in which the still picture recorded on the second recording unit (50) is reproduced *( col. 32, lines 30-35)*, and

a mode in which a still picture is reproduced *(i.e., Noted that during the APreview≅ mode, the ASTILL IMAGE≅ can be reproduced while the camera is in a motion recording mode; see col. 13, lines 50+, col. 27, lines 40+)* out of a picture recorded and reproducible as a moving picture on the second recording unit *(i.e., the memory device 50 as shown in Figs. 2 & 3)*.

Further, although Ootsuka '754 discloses the use of "a second recording unit" for recording the motion image in the recording medium 52 and recording the still image in the

recording unit 51, Ootsuka '754 does not explicitly show the use of particular "both moving pictures and also pictures to be reproduced as still pictures are recorded on a same second recording medium; and in a reproducing mode, the still picture is reproduced out of the moving picture which is recorded on the second recording medium to be reproduced as the moving picture as recited in the present claimed invention.

However, the above-mentioned claimed laminations are well known in the art as evidenced by Kozuki '943. In particular, Kozuki '943 clearly teaches it is conventionally well-known in the art to use a second recording medium (i.e., noted the use of recording medium 1 as shown in Figs. 3, 5 and 9 of Kozuki '943) for recording/reproducing both moving pictures (i.e., noted the tracks M1-M18 of Fig. 9) and also pictures to be reproduced as still pictures (i.e., noted the repeated M5 track of still image contents within the moving image tracks M1-M18 and the still image contents of the respective tracks S5-1 to S5-8 are recorded on the same recording medium 1) are recorded on a same recording medium (i.e., noted the use of a magnetic tape 1 for recording both moving/still images thereon, thus, "the second recording medium" as claimed is equal to the magnetic tape "1" as taught by Kozuki '943), so that during the reproducing mode, the still image data (i.e., the track M5 of Fig. 9) may be reproduced out of the moving picture (i.e., noted the tracks M1-M18 of Fig. 9) which is recorded on the second recording medium (i.e., the magnetic tape 1 of the camera) to be reproduced as the moving picture (see col. 8, lines 15-50). In view of this, it is clearly well-known in the art that the still image data portion (i.e., col. 8, lines 45+) may be selectively extracted and reproduced out of a picture recorded as a moving picture on the same recording medium tape so that it is possible for an operator to visually confirm the substantial contents of the scene.

In view of this, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Ootsuka '754 as taught by Kozuki '943, since Kozuki '943 suggested in col. 8, lines 45+ that such a modification would enable the operator to easily confirm the timing when the still image was recorded and the contents thereof, and moreover, such a modification would obviously reduce the cost and size of the overall system of Ootsuka '754 because it is only require to use a single recording medium to recorded the still and moving image data as taught by Kozuki '943.

Regarding claim 32, Ootsuka '754 discloses wherein the information recorded on the first recording medium is information used when the still picture recorded on the first recording medium is printed (i.e., sees col. 6, lines 60-col. 7, line 1 of Ootsuka '754).

Regarding claim 33, Ootsuka '754 discloses wherein, in any of the modes in which the moving picture is recorded, as aspect ratio of the picture can be varied (col. 23, lines 35+ and col. 24, lines 1+ of Ootsuka '754).

Regarding claim 34, Ootsuka '754 discloses a display for displaying the still picture, the moving picture, or information in any of the reproducing mode (i.e., see Figs. 12-17 of Ootsuka '754).

Regarding claim 35, please see the examiner's comment with respect to claim 31 as discussed above.

Regarding claim 36, please see the examiner's comment with respect to claim 32 as discussed above.

As for claim 37, please see the examiner's comment with respect to claim 33 as discussed above.

Regarding claim 38, please see the examiner's comment with respect to claim 34 as discussed above.

Regarding claim 39, please see the examiner's comment with respect to claims 31 & 33 as discussed above.

Regarding claim 41, please see the examiner's comment with respect to claim 31 & 33 as discussed above.

Regarding claims 40 and 42, Ootsuka '754 discloses wherein, a display for displaying a still picture, a moving picture, or information in any of the reproducing modes *(*see Figs. 12-17 of Ootsuka '754*)*.

***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Juri '693 (U.S. 5,999,693) discloses the system for reproducing the still image out of the moving image data.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aung S. Moe whose telephone number is 571-272-7314. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward F. Urban can be reached on 571-272-7899. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aung S. Moe
Primary Examiner
Art Unit 2685

A. Moe
September 16, 2005